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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,235	04/29/2005	Masaya Nishio	271564US0PCT	5068
22850 7590 10/01/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER WINTERBERG, NISSA M				
ART UNIT		PAPER NUMBER		
1618				
NOTIFICATION DATE		DELIVERY MODE		
10/01/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/533,235

**Applicant(s)**

NISHIO, MASAYA

**Examiner**

Nissa M. Westerberg

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 11 - 13 is/are rejected.
- 7) ☒ Claim(s) 5 - 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 4/29/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5 – 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112 - 2<sup>nd</sup> Paragraph***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. When referring to a polymer, the phrase “average molecular weight” is indefinite. As shown by Odian (1991), a polymer can have a variety of molecular weights, such as the number average molecular weight (p 20) or the weight average molecular weight (p 21) and it is unclear which of these is being claimed.

4. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 13 provides for the use of a liquid skin protective composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6. Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 4 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 07-277923 (JP'923).

JP'923 discloses oily cosmetic formulations comprising a blend of component (A), a linear copolymer containing a polysiloxane-polyoxyalkylene block and a liquid polar oil (CAPLUS abstract). The number-average molecular weight of component A ranges from 400 – 10,000 (CAPLUS abstract). Paraffin, ceresin, Vaseline™, or isoparaffin may also be included (§ [0013] of the machine translation). Possible forms of the oily cosmetic include lip stick, foundation, eye shadow, rouge and lip cream (§ [0014]). In the formulations, no water is present. A lipstick comprising  $[(\text{SiMe}_2\text{O})_{40}\text{SiRMe}_2(\text{CH}_2)_{40}(\text{C}_2\text{HO})_{18}(\text{C}_3\text{H}_6\text{O})_{33}(\text{CH}_2)_4]$  16.1, 2-octyldecaonol, pigments, candelilla wax and vaseline is prepared (CAPLUS abstract).

The viscosity of the formulations is not specified. Either the formulations prepared meet the limitation of claim 3 inherently or it would have been obvious to one of ordinary skill in the art at the time of the instant invention to alter the viscosity of the formulation depending on the product being prepared. The functional/desirable viscosity of a skin foundation is not necessarily the same as the functional/desirable viscosity of a lipstick. It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the

applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1 – 4, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-277923 as applied to claims 1 – 4 and 13 above and further in view of Ziemelis et al. (US 4,472,566).

JP'923 discloses oily cosmetic formulations comprising a blend of component (A), a linear copolymer containing a polysiloxane-polyoxyalkylene block and a liquid polar oil (CAPLUS abstract). The number-average molecular weight of component A

ranges from 100 – 10,000 (CAPLUS abstract). Paraffin, ceresin, Vaseline™, or isoparaffin may also be included (§ [0013] of the machine translation). Possible forms of the oily cosmetic include lip stick, foundation, eye shadow, rouge and lip cream (§ [0014]). In the formulations, no water is present. A lipstick comprising  $[(\text{SiMe}_2\text{O})_{40}\text{SiRMe}_2(\text{CH}_2)_{40}(\text{C}_2\text{HO})_{18}(\text{C}_3\text{H}_6\text{O})_{33}(\text{CH}_2)_4]16.1$ , 2-octyldecaonol, pigments, candelilla wax and vaseline is prepared (CAPLUS abstract).

JP'923 does not disclose the application of the oily cosmetic by spraying.

Ziemelis et al. discloses that the polydiorganosiloxane compositions can be applied by a variety of methods known to those skilled in the art, including wiped or rubbed on the skin, rubbed or sprayed onto fur or massaged, combed or brushed into hair (col 6, ln 62 – col 7, ln 2).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to take the oily cosmetic taught by JP'923 and to apply it by means of spraying, a method taught by Ziemelis et al. as a suitable application method for polysiloxane containing compositions.

12. Claims 1 – 4 and 11 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'923 and Ziemelis et al. as applied to claims 1 – 4, 11 and 13 above, and further in view of Smith et al. (US 6,001,380).

JP'923 discloses oily cosmetic compositions containing polysiloxane polymers which can be applied by a variety of means, such as spray, wiping or rubbing.

Neither reference discloses the application of the composition using a material impregnated with the composition.

Smith et al. discloses a method for applying dermatological agents to the skin using an applicator sheet containing (impregnated with) the compositions to be delivered to the skin (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to take the cosmetic composition taught by JP'923 and to apply the composition, by spraying, wiping or rubbing the product directly onto the skin or to use a sheet impregnated with the composition as taught by Smith et al. and Ziemelis et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571)270-3532. The examiner can normally be reached on M - F, 8 a.m. - 4 p.m. ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

NMW